REMARKS

Claims 1, 2, 4-10 and 12-15 are pending in the instant application. Claims 1, 2, 4-10 and 12-15 have been rejected. Claim 1 has been amended. No new matter has been added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection of Claims Under 35 U.S.C. 103(a)

Claims 1, 2 4-10 and 12-15 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Acton et al. (US Patent 5,965,790), in view of Calvo et al. (1993) and Baracchini et al. (US Patent No. 5,801,154). The Examiner suggests that it would have been *prima facie* obvious to one of ordinary skill to make antisense to inhibit CD36L1 because antisense inhibition was taught by Acton et al., the sequence of the gene was provided by Calvo et al., and Baracchini teach the desirability of modifying antisense compounds. The Examiner suggests one of skill would have been motivated to create such compounds due to the teaching of Acton et al. regarding the significance of this gene in disease and that Baracchini teach the need for modified oligonucleotides. The Examiner suggests one of skill would have had an expectation of

success based on the teachings of Acton et al. and Baracchini et al. Applicant respectfully traverses this rejection.

At the outset, claim 1 and its dependent claims have been amended to recite antisense compounds targeted to specific nucleobase regions of the nucleic acid molecules encoding CD36L1 of SEQ ID NO: 3. Support for this amendment to the claims can be found throughout the specification as filed but in particular at pages 87-90.

Acton et al. (US Patent 5,965,790) disclose an isolated nucleic acid molecule which is capable of hybridizing to a nucleic acid molecule consisting of the nucleotide sequence of the human CD36L1 promoter or the complement thereof, and wherein the nucleic acid is capable of modulating transcription of a gene operably linked to the nucleic acid that encodes a CD36L1 receptor. The nucleic acid is disclosed to be capable of activating or enhancing transcription of this gene. Antisense compounds are only generally disclosed. Nowhere does this patent teach or suggest antisense compounds from 8 to 50 nucleobases in length that target specific nucleobase regions of the CD36L1 nucleic acid molecule of SEQ ID NO: 3 as claimed. It is only with the specification in hand that one of skill would understand which nucleobase regions could be

successfully targeted with antisense compounds as claimed. Therefore, this primary reference, either alone or when combined with other references, fails to teach the limitations of the claims.

The secondary references cited fail to overcome the deficiencies in teaching of the primary references.

Calvo et al. (1993) discloses the sequence of CD36L1. Nowhere does this reference teach or suggest antisense compounds of any type targeted to CD36L1 nucleic acid molecules as claimed, including specific regions of CD36L1 to be targeted by antisense. Therefore, this reference also fails to teach the limitations of the claims as amended.

Baracchini et al. (US Patent 5,801,154) teach methods of modifying antisense oligonucleotides to enhance activity. However, nowhere does this patent teach or suggest antisense oligonucleotides 8 to 50 nucleobases in length targeted to CD36L1 nucleic acid molecules, or any region of a CD36L1 nucleic acid molecule.

To establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in

the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art must teach or suggest all claim limitations. Clearly, the combination of prior art cited fails to teach or suggest the limitations of the claims as amended, which claim antisense compounds targeted to specific nucleobase regions of a nucleic acid molecule encoding CD36L1, and thus cannot render the instant claimed invention obvious. Moreover, a mere teaching of the concept of antisense for a gene does not give one the expectation of success for using antisense as disclosed in the instant invention. Withdrawal of this rejection is therefore respectfully requested.

II. Conclusion

Applicant believes that the foregoing comprises a full and complete response to the Office Action of record. Accordingly,

favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

Jane Massey Licata
Registration No. 32,257

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Licata & Tyrrell P.C.
66 E. Main Street
Marlton, NJ 08053

856-810-1515